ESTTA Tracking number: **ESTTA702862**

Filing date: **10/16/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221689
Party	Defendant GabRy, Inc.
Correspondence Address	LISA M DAWSON 18 WEBELO PLACE PALM COAST, FL 32164-7769 UNITED STATES lisamdawsonesq@gmail.com
Submission	Other Motions/Papers
Filer's Name	Lisa M. Dawson
Filer's e-mail	lisamdawsonesq@gmail.com
Signature	/Lisa M Dawson/
Date	10/16/2015
Attachments	talkit response and ans_20151016193042.pdf(367595 bytes)

IN THE UNTITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 86-241, 947
Filed on April 3, 2014
For the Mark TALKiT
Published on October 28, 2014

3M Company,	)	
	)	
	)	
Opposer,	)	
	)	
	)	Opposition No. 91221689
v.	)	
	)	
GabRy, Inc,	)	
	)	
Applicant	)	

RESPONSE TO NOTICE OF DEFAULT JUDGEMENT AND MOTION FOR LEAVE TO FILE A LATE ANSWER

Applicant GabRy, Inc, by its undersigned attorneys, submit the herein pursuant to Fed. R. Civ P. 55(c), Fed. R. Civ. P. 6(b), and TBMP §310.03(c), respectfully moves the Board to set aside the notice of default judgement and on the same grounds to grant leave to file a la Answer.

BACKGROUND:

On April 27, 2015, 3M Company ("Opposer") filed their Notice of Opposition against Application Serial Number 86241947 for the mark "TALKiT." Attempts to resolve the issues were made prior to the opposition being filed. Discussions were initiated on October 17, 2014 via email. Several extensions of time of sought to file opposition and granted based on the ongoing discussions in attempt to resolve the issue. When Opposer did file the Notice of Opposition to the mark, it did so on the grounds of priority of use and likelihood of confusion

under Section 2(d) of the Trademark Act, 15 U.S.C §1052(d) and dilution under Section 43© of the Trademark Act, 15 U.S.C § 1125(c).

On April 27, 2015, the Board instituted this proceeding and set the Time to Answer at June 6, 2015. On June 2, 2015, the parties were close to resolution, however we were unable to agree to one last issue. On June 8 the undersigned requested an extension of time to file an answer in order to further attempt to resolve the matter and was granted a thirty (30) day extension with the new Time to Answer set for July 8, 2015.

On July 8, 2015, the undersigned requested another extension to file the Answer and was which was granted, setting the Time to Answer at August 7, 2015. On August 5, 2015 another short extension was requested of the Opposer by email, however, no response was received until August 10, 2015 which was after the deadline to file an Answer. It was the undersigned's intention to file another stipulated motion to extend the time to answer to August 24, 2015 however when the undersigned attempted to the so, the Trademark Trial and Appeal Board Electronic Filing System prohibited the action. Additional delays from the end of August until now have been the result of attempts to resolve the remaining outstanding issue presented by the Opposer in order to fully resolve the matter.

All of the extensions of time sought by both the Opposer in filing the Notice of Opposition and the Applicant in filing the answer were in an effort to resolve the matter without further litigation. The initial notice of the opposition to the Applicant's mark was received in July 2014 and the first attempts make to resolve the matter were made in October 2014. In April 2015 the Notice of Opposition was filed which is nine months after it was made known that the Opposer intended to oppose the Application. We are now in the fourth month from when the

Answer was due. It is the undersigned's contention that there has been no prejudice to the Opposer in the four month delay.

LEGAL ARGUMENT:

In considering whether to set aside a default judgement, the TTAB has stated "the good and sufficient cause standard, in the context of 37 C.F.R. §2.132 (a), is equivalent to the "excusable neglect" standard which would have to be met by any motion under FRCP 6(b) to reopen the plaintiff's testimony period." HKG Indus., Inc v. Perma-Pipe Inc., 49 UPOQ2d 1156, 1157 (T.T.A.B 1998).

In analyzing "excusable neglect" the TTAB has relied on the Supreme Court's discussion of excusable neglect in Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership, 507 U.S. 380, 113 S.Ct. 1489, 123 L.Ed.2d (1993). See, Mattell, Inc v. Henson, 88 Fed Appx. 401 (Fed. Cir. 2004) (confirming applicability of Pioneer to TTAB proceedings).

The Pioneer case dealt with permitting a late filing if the movant's failure to comply with an earlier deadline was the result of excusable neglect. The Supreme Court defined the inquiry into excusable neglect as:

> "...at bottom an equitable one, taking into account all of the relevant circumstances surrounding the party's omission. These include. . .the danger of prejudice to the non-moving party, the length of the delay and its potential impact on the judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith."

Id. at 395, 113 S. Ct. 1489. In practice before this Board in particular, the TTAB "is lenient in accepting late filed answers when the delay is not excessive." See, Mattell, Inc v. Henson, 88 Fed Appx. 401 (Fed. Cir. 2004).

Under the circumstances, the Board may exercise its leniency and authorize the late filing or an Answer. It is difficult to see how the Opposer could be prejudiced in the delay between August 7, 2015 and October 16, 2015. Further, the expected delay is even shorter in that the Opposer agreed to another extension of time to file on August 10th but did not propose a time period.

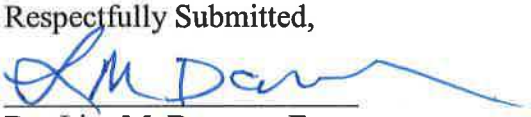
In addition to there being no significant delay, there is no impact on any other proceedings either judicial proceeding or commercial proceedings. The reason for the delay can be characterized as honest error after realizing that there was no longer the ability to file a stipulated motion through the electronic filing system followed by ongoing discussions between the undersigned and the Applicant to resolve the remaining issue preventing the ultimate resolution of the Opposition.

The Answer is attached to this motion and represents the meritorious defense to the Opposition.

CONCLUSION:

For the foregoing reasons, Applicant respectfully requests that the notice of default entered in the matter be set aside and that leave be granted to file a late Answer.

Respectfully Submitted,



By: Lisa M. Dawson, Esq
Law Office of Lisa M. Dawson, Esq
18 Webelo Place
Palm Coast, FL 32164
(386)338-2717
Email:lisamdawsonesq@gmail.com
Attorney for Applicant

Dated: October 16, 2015

IN THE UNTITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 86-241, 947
Filed on April 3, 2014
For the Mark TALKiT
Published on October 28, 2014

3M Company,	)	
	)	
	)	
Opposer,	)	
	)	
	)	Opposition No. 91221689
v.	)	
	)	
GabRy, Inc,	)	
	)	
Applicant	)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant GabRy, Inc, for its answer to the Notice of Opposition filed by 3M Company against application for registration of GabRy, Inc's trademark TALKiT, Serial Number 86241947 filed August 3, 2014, and published in the Official Gazette on October 28, 2014, pleads and avers as follows:

1. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 1.
2. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 2.
3. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 3.

4. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 4.
5. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 5.
6. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 6.
7. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 7.
8. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 8.
9. Applicant admits to the allegations of Paragraph 9.
10. Applicant admits to the allegations of Paragraph 10.
11. Applicant admits to the allegations of Paragraph 11.
12. Applicant admits to the allegations of Paragraph 12.
13. Applicant admits to the allegations of Paragraph 13.
14. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 14.
15. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 15.
16. Applicant denies knowledge and information sufficient to admit or deny allegations of Paragraph 16.
17. Applicant denies each and every allegation contained in Paragraph 17.
18. Applicant denies each and every allegation contained in Paragraph 18.

19. Applicant denies each and every allegation contained in Paragraph 19.

20. Applicant denies each and every allegation contained in Paragraph 20.

21. Applicant denies each and every allegation contained in Paragraph 21. Applicant denies that permission from the Opposer is required to use or register the mark.

22. Applicant denies each and every allegation contained in Paragraph 22.

23. Applicant denies each and every allegation contained in Paragraph 23.

24. Applicant denies each and every allegation contained in Paragraph 24.

AFFIRMATIVE DEFENSES

First Affirmative Defense

As a result of Applicant's continuous use of the Mark since the time of the Applicant's adoption thereof, the Mark has developed significant goodwill among the consuming public and consumer acceptance of the services offered by Applicant in conjunction with the Mark. Such goodwill and widespread usage has caused the Mark to acquire distinctiveness with respect to the Applicant and cause the Mark to become a valuable asset of Applicant.

Second Affirmative Defense

There is no likelihood of confusion, mistake or deception because, *inter alia,* the Mark and the alleged trademark of Opposer are not confusingly similar.

Third Affirmative Defense

Any similarity between the Mark and Opposer's alleged trademark is restricted to that portion of the Mark consisting of the work "iT" which is not distinctive. As a result, under the antidissection rule any secondary meaning Opposer may have in its

alleged POST-IT trademark is narrowly circumscribed to the exact trademark alleged and does not extend to any other feature beyond the word "iT"

Fourth Affirmative Defense

There is no likelihood of dilution by blurring because Opposer's and Applicant's marks are not sufficiently similar; there are, upon information and belief, numerous uses and registrations of third party marks with "it" in the mark; Applicant do not intend any association with Opposer's marks; and upon information and belief, ordinary prospective purchasers pf Applicant's products do not associate Applicant's and Opposer's marks.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed and the registration for the mark TALKiT be issued to the Applicant.

Respectfully Submitted,

By: Lisa M. Dawson, Esq
Law Office of Lisa M. Dawson, Esq
18 Webelo Place
Palm Coast, FL 32164
(386)338-2717
Email:lisamdawsonesq@gmail.com
Attorney for Applicant

Dated: October 16, 2015

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 16th day of October, 2015, a true copy of the foregoing REPSONSE TO NOTICE OF DEFAULT JUDGEMENT AND MOTION FOR LEAVE TO FILE A LATE ANSWER and ANSWER AND AFFIRMATIVE DEFENSE was served in the following manner:

VIA EMAIL AND FIRST CLASS MAIL

Pirkey Barber PLLC
600 Congress Avenue, Suite 2120
Austin, Texas 78701

Email: wlarson@pirkeybarber.com
bbarber@pirkeybarber.com

CERTIFICATE OF ELECTRONIC FILING

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 16th day of October, 2015

By: Lisa M. Dawson, Esq
Law Office of Lisa M. Dawson, Esq
18 Webelo Place
Palm Coast, FL 32164
(386)338-2717
Email:lisamdawsonesq@gmail.com
Attorney for Applicant